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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/440,243

11/15/1999

FRANK W. LIEBENOW

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2702

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05/06/2004

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EXAMINER

EICKHOLT, EUGENE H

ART UNIT

PAPER NUMBER

2854

DATE MAILED: 05/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/440,243	Applicant(s) LIEBENOW, FRANK W.	
	Examiner Eugene H Eickholt	Art Unit 2854	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2004.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-9, 12-22, 24-29 and 31-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-9, 15-22, 24-29, 34, 35 and 39-47 is/are allowed.
- 6) ☒ Claim(s) 1-3, 12-14 and 37 is/are rejected.
- 7) ☒ Claim(s) 31-33, 36 and 38 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 12, 14 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldsmith.

The font style or string black and white designation is a subset for display on display terminal 14 which is selected and then overridden either automatically or by user instructions to print in a highlight color. The rest of the non-overridden black and white designated fonts or strings are printed in black and white. See col. 7, lines 1-35 and lines 40-47 and col. 6, lines 49-58.

Applicant has argued that the reference fails to teach that the color designation remains unchanged for display. Goldsmith at column 5, lines 24-49 teaches control color printing control. The black and white original is scanned to provide an "electronic image of said black and white only original". One of ordinary skill in the art printing art at the time of applicants invention would have found it obvious to use a black and white monitor for terminal 14. Motivation would have been that the original document is only black and white. A more expensive color monitor would not be necessary. Additionally, the reference at col. 5, lines 39-40 teaches automatic -generation of color printing instructions only and makes no mention of changing the scanned electronic image on the terminal 14. Lines 51-52 col. 5 refers to "imaging and printing control functions and

logic with conventional software instructions". A black and white terminal is such a conventional interfaces .

Regarding claim 3, automatic high-light color printing is taught at col. 5, line 33.

Regarding claim 12, see the explanation of the rejection of claim 1. The claimed computer readable medium is anticipated by the pre-programming (and storing ) programmable software controls disclosed at col. 7, lines 2-6. The PC interface is the personal computer receiving the software programming.

Regarding claim 14, see the explanation of the rejection of claim 3. Regarding claim 37, see col. 7, lines 11-18 about special notes using small font.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldsmith in view of Nickel et al.

Goldsmith is applied as in the above rejection. It does not teach going from a color display text to a black printed text. Nickel et al at col. 5, lines 24-27 teaches this reverse scanning of a color image to produce a printed black text image. As Goldsmith can print black already see col. 7, line 27, it would have been obvious to one of ordinary skill in the printing art to have modified Goldsmith to also scan color images to be automatically or by operator setting printed out as black images. Motivations would

Art Unit: 2854

have been more flexibility to produce printed copies where only a color original is at hand and cheaper black inked copies can suffice for the use intended.

Claims 31-33, 36 and 38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 4-9, 15-22, 24-29, 34-35 and 39-47 stand allowed.

Claim 12 is also objected to for the double recitation of "such that the subset is printed in accordance with the print color designation".

A shortened statutory period 3 months is set to respond.

Eickholt/ds

04/16/04

  
EUGENE H. EICKHOLT  
PRIMARY EXAMINER